



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/955,232      | 09/18/2001  | Todd Mark Kelsey     | ROC920010197US1     | 8310             |

7590 06/23/2006

Gero G. McClellan  
Moser, Patterson & Sheridan, L.L.P.  
Suite 1500  
3040 Post Oak Boulevard  
Houston, TX 77056-6582

|          |
|----------|
| EXAMINER |
|----------|

HANG, VU B

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2625

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/955,232

Applicant(s)

KELSEY, TODD MARK

Examiner

Vu B. Hang

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Response to Arguments*

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (US Pub. 2003/0011801 A1) in view of Yu (US Patent 6,707,568 B1).

Regarding **Claims 1, 11 and 19**, Simpson discloses a method for controlling printable content from textual and graphical sources (see Fig.9, paragraph [0005] and paragraph [0007]), comprising: monitoring for a print request (see Fig.9 (502) and paragraph [0068]); matching a print file with stored identification data (see paragraph [0020] and paragraph [0065]) and transforming the print file in accordance with the stored print options (see paragraph [0021] and paragraph [0039]). Simpson, however, fails to disclose intercepting the print file generated by the driver from the print request. Yu, however, discloses intercepting the print file generated by the print driver and transforming the print file in accordance to with the stored print options (see Fig.3A, Fig.4B and Col.3, Line 46-52), whereby the transformed print file produces a printed output different from a printed output that would have been produced by the print file generated by the print driver (see Fig.3A and Col.3, Line 46-52).

Simpson and Yu are combinable because they are from the same field of invention, namely print option configuration methods. At the time of the invention, it would have been obvious for one skilled in the art to include to a print option configuration method a means for intercepting the print file generated by the driver and transforming the print file in accordance to a stored print option data. The motivation would be to eliminate the need to install a new print driver in cases where the current driver does not support the printing options specified by the user or an application. The installation of a new print driver would cause valuable time, energy and money to be consumed.

Regarding **Claims 2, 12 and 23**, Simpson further discloses that the configuration data file is configured to store the identification data and print options (see Fig.5 and Fig. 9 (510), the print monitoring module is configured for monitoring the print request (see Fig.9 (502)), and transformation program module is configured for transforming the print file (see paragraph [0021] and paragraph [0039]).

Regarding **Claims 3 and 13**, Simpson further discloses identifying identification data in the print request and comparing the identification data in the print request to the stored identification data in a currently selected print configuration data file (see paragraph [0020] and paragraph [0065]).

Regarding **Claims 4, 20 and 30**, Simpson further discloses printing the transformed print file to an output device (Fig.2 (174)).

Regarding **Claims 5, 14, 21 and 31**, Simpson and Yu disclose the method of Claim 1 but fail to disclose selecting an output device from a group consisting of a printer, copier and scanner. At the time of the invention, it would have been obvious for one skilled in the art to use

a multifunction peripheral device that has a printing, copying and scanning function. The motivation would be to provide multiple options for producing the final print products.

Regarding **Claims 6, 15 and 28**, Simpson further discloses that the stored data and the print options are user configured (see Fig.5 and paragraph [0031]).

Regarding **Claims 7 and 16**, Simpson further discloses that prior to the monitoring step, receiving the identification data and the print options from a graphical user interface generated by a print option formatting module (see Fig.5 and paragraph [0031]).

Regarding **Claims 8 and 17**, Simpson further discloses selecting a current print configuration data file from a listing of at least one print configuration data file (see Fig.10 (534,540) and paragraph [0070]).

Regarding **Claims 9 and 32**, Yu further discloses that the print file is a spooled print file (see Fig.3A and Col.3, Line 46-52). At the time of the invention, it would have been obvious to have the print file as spooled file. The motivation would be to perform print data processing and transformation at the printing device.

Regarding **Claims 10 and 18**, Yu further discloses that the print driver configures the print file prior to the transformation step (see Fig.3A and Col.3, Line 46-52). At the time of the invention, it would have been obvious to have the print driver configure the print file prior to the transformation step. The motivation would be to keep the print driver from being involved in the transformation process. This would eliminate the need for a new print driver to be installed.

Regarding **Claim 22**, Yu further discloses that print medium formatting program may access other programs or data files within the system (see Fig.3A and Col.3, Line 22-24). At the time of the invention, it would have been obvious to have the print medium formatting program

loaded and accessible to a program selected from a group consisting of an operating system, a print driver and an application program. The motivation would be to gather the necessary print data information from the selected program for performing the formatting process.

Regarding **Claim 24**, Simpson further discloses that the identification data comprises one of print configuration data file (see Fig.10 (534,536) and paragraph [0039]), one of output device (see Fig. 4 (266), Fig.11 (562) and paragraph [0072]) and one of application program (see Fig.4 (270) and paragraph [0051]).

Regarding **Claim 25**, Simpson further discloses print options including selectable print color, resolution, size, pages per page and printable contents (see paragraph [0021 and paragraph [0023]).

Regarding **Claim 26**, Simpson further discloses that printable contents could include text, headers, banners, advertisements and solid backgrounds (see paragraph [0023]) but fails to include text only and user-highlighted contents. Simpson, however, teaches that other known print option features can be included (see paragraph [0021]). At the time of the invention, it would have been obvious for one skilled in the art to easily incorporate special print formatting features such as text only and user-highlighted contents printing. The motivation would be to provide users with more print option selections.

Regarding **Claim 27**, the rational provided in the rejections of Claims 1, 3 and 7 are herein.

Regarding **Claim 29**, Simpson further discloses user options of creating a new a print configuration data file, editing an existing print data configuration file, deleting the print data

configuration file and accepting the print data configuration file (see Fig.5 and paragraph [0061]).


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tylwer M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang  
Assistant Examiner



JOSEPH R. POKRZYWA  
PRIMARY EXAMINER